

ESTTA Tracking number: **ESTTA713054**

Filing date: **12/07/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92059305
Party	Defendant Theodore A Stoner
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Submission	Opposition/Response to Motion
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Date	12/07/2015
Attachments	Opposition to Motion to Strike.pdf(147460 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
The Trademark Trial and Appeal Board**

In the matter of U.S. Registration 3,700,403  
For the mark BONGO BI-LINGO BUDDY  
Registered on the Principal Register on October 20, 2009

MWR Holdings, LLC,	:	
	:	
Petitioner,	:	
	:	
vs.	:	Cancellation No. 92059305
	:	
Stoner, Theodore A.,	:	
	:	
Registrant.	:	

**OPPOSITION TO MOTION TO STRIKE**

COMES NOW the Registrant Theodore A. Stoner (hereinafter “Registrant”), by counsel, The Trademark Company, PLLC, and submits the instant opposition to Petitioner MWR Holdings, LLC’s (hereinafter “Petitioner”) Motion to Strike.

**STATEMENT OF FACTS**

1. On or about August 12, 2015 Petitioner filed a Motion for Summary Judgment.
2. On September 15, 2015 Registrant filed an Opposition to Petitioner’s Motion for Summary Judgment and a Counter-Motion for Summary Judgment.
3. On or about October 6, 2015 Petitioner filed a Reply in Support of Petitioner’s Motion for Summary Judgment.
4. On or about October 21, 2015 Petitioner filed an Opposition to Registrant’s Cross-Motion for Summary Judgment.
5. On or about November 10, 2015 Registrant filed a Reply in Support of Registrant’s Counter-Motion for Summary Judgment.

6. On or about November 17, 2015 Petitioner filed a Motion to Strike certain portions of Registrant's Reply in Support of its Counter-Motion for Summary Judgment.

### **ARGUMENT**

As grounds for filing the instant Motion Strike certain portions of Registrant's Reply in Support of its Counter-Motion for Summary Judgment, Petitioner alleges that Registrant's Reply in Support of its Counter-Motion for Summary Judgment contained an Affidavit consisting of facts that were not disclosed in any other evidence. Specifically, Petitioner alleges that Registrant failed to disclose what Registrant's mark was being used in connection to, why he selected the mark, when he first began using the mark, and where he had been using the mark.

Registrant's Affidavit to be used in support of Registrant's Reply in Support of its Counter-Motion for Summary Judgment was constructed not to introduce new evidence but in a way to certify previously supplied evidence. *See* Exhibit 1 of Registrant's Opposition to Motion for Summary Judgment and Counter-Motion for Summary Judgment (Prosecution History Document No. 18). Further, Registrant's Affidavit to be used in support of Registrant's Reply in Support of its Counter-Motion for Summary Judgment was in compliance with TBMP § 528.05(b), Fed. R. Civ. P. 56(c); *see also Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516, 1517 (TTAB 1993) (additional affidavit submitted with reply brief considered).

It is clear from Registrant's Opposition to Motion for Summary Judgment and Counter-Motion for Summary Judgment the Registrant had already introduced all the evidence that the Affidavit supports, namely, what Registrant's mark was being used in connection to, why he selected the mark, when he first began using the mark, and where he had been using the mark. There is not any new information that could not have been found in Registrant's Answers and Objections to Petitioner's First Set of Interrogatories and Registrant's Answers and Objections to

Petitioner's First Set of Document Requests attached (and referred to) as Exhibits 2 and 7 in Registrant's Opposition to Motion for Summary Judgment and Counter-Motion for Summary Judgment. Whether they were also produced as Exhibits in Registrant's Reply in Support of Registrant's Counter-Motion for Summary Judgment is of no matter. The information was previously incorporated into Registrant's Opposition to Motion for Summary Judgment and Counter-Motion for Summary Judgment and, accordingly, cannot be considered new evidence that Petitioner was not given a chance to respond to. Petitioner already had the opportunity to respond to the evidence in Petitioner's Opposition to Registrant's Counter-Motion for Summary Judgment. They should not have a second chance to respond to the same information.

Second, Registrant properly submitted a valid affidavit. Per the Trademark Trial and Appeal Board Manual of Procedure Section 528.06:

Affidavits may be submitted in support of, or in opposition to, a motion for summary judgment provided that they (1) are made on personal knowledge; (2) set forth such facts as would be admissible in evidence; and (3) show affirmatively that the affiant is competent to testify to the matters stated therein. This is so even though affidavits are self-serving in nature, and even though there is no opportunity for cross-examination of the affiant. However, an adverse party may have an opportunity for direct examination of the affiant, if a Fed. R. Civ. P. 56(d) motion to take the discovery deposition of the affiant is made and granted.

*See also* Fed. R. Civ. P. 56(c)(4). Registrant submitted a statement from a person competent to testify on the matters at hand, that was based on their personal knowledge, and that set forth facts admissible in evidence. Registrant fulfilled the requirements regarding an affidavit made to support their motion and the Petitioner should not be permitted to strike the same.

Accordingly, on the basis that Affidavit supporting Registrant's Reply in Support of Registrant's Counter-Motion for Summary Judgment was properly submitted and does not introduce any new evidence to which the Petitioner should have the opportunity to respond to, it is respectfully requested that the instant motion be denied.

## **CONCLUSION**

WHEREFORE Registrant respectfully requests the Board deny Petitioner's Motion to Strike Registrant's Affidavit supporting Registrant's Reply in Support of Registrant's Counter-Motion for Summary Judgment.

DATED this 7<sup>th</sup> day of December, 2015.

THE TRADEMARK COMPANY, PLLC

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The Trademark Trial and Appeal Board**

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vs.	:	Cancellation No. 92059305
	:	
Stoner, Theodore A.,	:	
	:	
Registrant.	:	

**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that I caused a copy of the foregoing this 7<sup>th</sup> of December, 2015,  
to be served, via first class mail, postage prepaid, upon:

William W Stroeve  
Greenberg Traurig LLP  
500 Campus Drive  
Florham Park, NJ 07932-0677

/Matthew H. Swyers/  
Matthew H. Swyers